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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,006	12/30/2003	Ellen Lasch	80655.8800	8389
66170 7590 12/01/2008 Snell & Wilmer L.L.P. (AMEX) ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202				
EXAMINER MAI, THIEN T				
ART UNIT 2887		PAPER NUMBER		
NOTIFICATION DATE 12/01/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/749,006

Applicant(s)

LASCH ET AL.

Examiner

Thien T. Mai

Art Unit

2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 6, 9, 11, 12, 15-22, 25, 54 and 58-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6, 9, 11-12, 15-22, 25, 54 and 58-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of Priorities Cited (PTO-602)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/15/2008 has been entered.

Claim Objections

Claim 1 line 6: "said entire area of said second layer" lacks antecedent basis. Only "an entire area of said transaction card" was previously recited. For examination purposes, it is treated as "an entire area of said second layer"

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim(s) 1, 4, 6, 9, 11, 15-16, 18-19, 59-61, 63 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (US 6,025,283) in view of Takahashi et al. (US 5,444,225)

Roberts discloses

1. A transaction card comprising:

a first metal layer 20 which is continuous over the entire area of said transaction card (Fig. 1-3);

a second layer (see hologram 18);

wherein said first metal layer is coextensive with said entire area of said second layer;

wherein said first metal layer and said second layer are in uniform, direct contact (Fig. 1); and

a recordable medium 16 on or within incorporated into said transaction card for storing information relating to a transaction account and configured to conduct a transaction at a point of sale terminal.

Roberts is unclear with respect to the second layer comprises of metal.

Takahashi et al. teaches a card with metallic base layer having a hologram thereon; the hologram comprises of at least titanium (col. 3 lines 50-57, col. 7 lines 34-57)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the hologram and related teachings of Takahashi et al. to provide reflective and attractive properties to the card while further providing an encoded message in the hologram.

Re claim 4, first metal layer 20 is at outermost surface (Fig. 3)

Re claim 6, second layer is laminated with metal layer (col. 5 lines 1-3)

Re claim 9, adhesive is disposed between first metal layer and second layer (col. 5 lines 1-3)

Re claim 11, said recordable medium comprises a magnetic stripe broadly interpreted as being disposed on the first layer of metal, i.e. when the card is turned upside down. Furthermore, Takahashi's magnetic stripe in the hologram is also on metal layer of card.

Re claim 15, further comprising: a coating (i.e. lacquer) on an outermost surface of said transaction card.

Re claim 16, the lacquer is inherently of polymeric material. See <http://en.wikipedia.org/wiki/Lacquer>.

Re claim 18-19, a pattern is etched onto metal layer (see Summary)

Re claim 59-61, the portion where metal layer is embossed is broadly and inherently interpreted as thinner than the rest since the portion is stretched out or removed due to stamping and/or laser etching and/or engraving process.

Re claim 63, Fig. 1 shows brand 15 being etched onto a pocket window having 4 sides and a background/bottom surface where the embossed/etched letters are on. The claim can also be broadly interpreted as the metal layer having a bottom surface that is next to rubber surface 24.

3. Claim(s) 12 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (US 5,444,225) further in view of Okazaki et al. (5421618)

Takahashi et al. teaches a second layer (i.e. hologram) in direct contact with a first metal layer of the card (col. 3 lines 50-57, col. 7 lines 34-57).

Takahashi et al. is silent with respect to magnetic stripe being on the second layer.

Okazaki et al. teaches a hologram having a magnetic stripe thereon and comprises of a metal (Fig. 1, 3, col. 5 lines 52-57)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Okazaki et al. to provide security by making it difficult to directly transfer the information written on the magnetic layer to a magnetic stripe of another card.

4. Claim(s) 16-17 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (6025283) modified by Takahashi et al. (US 5,444,225) further in view of Kaminsky (20040121257).

Re claim 16-17 Roberts discloses all limitations set forth in this claim as discussed above, except a surface coating that is made of polyethylene terephthalate and comprises a dye for providing color to the card.

Kaminsky discloses a transaction card with a metal layer 16 coated on the surface with a colored dye donor layer made of polyethelene terephthalate (Specification par. 0078, 0091).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the color dye of Kaminsky with the motivation for the desire for manufacturing cards with different colors for different financial institutions.

5. Claim(s) 20, 22, 54, 58, 62 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (6025283) modified by Takahashi et al. (US 5,444,225) further in view of NPL publication NN86044723 (NPL hereinafter) and/or Conner (20050194453)

Re claim 20, 62, Roberts is unclear whether a chip is embedded although Roberts mentioned SMART technology

NPL discloses a microchip embedded in a metal card. NPL further discloses what appears to be two metal layers 20, 22 of non-precious metal Copper or steel adjacent to each other, each are at least 5 mils thick yielding a total of at least 10 mils thick.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of NPL for more storage capacity.

Re claim 22, 54, 58, Roberts silent with respect to the thickness of the metal layer being 30 mils and of Titanium or stainless steel.

Conner discloses the layers making up the transaction card can alternately be made all of titanium layers or alloys or other metals (Specification par. 0076) and the thickness of the card is desired to be compliant with ISO-7816 standard thickness of .031 inches (or 30 mils) (Specification par. 0068-69). Accordingly, the total thickness of the metal layer of the card in this embodiment is about 30 mils thick.

Furthermore, the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of NPL, Conner and the Court to arrive a desirable thickness.

6. Claim(s) 21 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (6025283) modified by Takahashi et al. (US 5,444,225) further in view of Hinata (20030202151).

Regarding claim(s) 21, Roberts discloses all limitations set forth in this claim as discussed above, except an oxide layer on a surface of the metal layer being formed from an anodizing process. Hinata discloses such technique is known in the art. See reference text below:

"The insulator 66 is fabricated of tantalum oxide (Ta.sub.2O.sub.3) that is obtained by oxidizing the first metal layer 65 through anodizing. When the first metal layer 65 is anodized, the surface of the first layer 79a of the line wiring 79 is also oxidized. Similarly, a second layer 79b fabricated of tantalum oxide is thus formed." (Specification par. 0133)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize anodizing technique to achieve bonding thus preventing the metal layer from peeling off.

7. Claim(s) 25 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (6025283) modified by Takahashi et al. (US 5,444,225) further in view of Hara (US Patent 4,876,441, Hara'441 hereafter). The teachings of Conner/Roberts have been discussed above.

Regarding claim(s) 25, Roberts discloses all limitations set forth in this claim as discussed above except for the transaction card to have chamfer edges around the perimeter of the card. Hara'441 discloses chamfering edges are provided around the perimeter for protection of the core portion which houses peripherals (col. 11 lines 11-35, Fig. 17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to be motivated to utilize Hara's invention to further protect the electronics inside such as chip and to avoid incidents caused by sharp and non-chamfered edges.

Remarks

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Pentz et al. (6471127) is an example showing a magnetic strip can be placed anywhere on the card.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve S. Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2887

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thien T Mai/
Examiner, Art Unit 2887

/EDWYN LABAZE/
Primary Examiner, Art Unit 2887